

REMARKS

The Office Action mailed March 12, 2003, has been carefully considered. The present Response is intended to be a complete reply thereto and to place the case in condition for allowance. Claims 1-19 are pending.

THE ABSTRACT IS PROPER

The Abstract of the disclosure stand objected to because it contains the terms "comprises." A new abstract is submitted herewith where the word "comprises" has been amended to "contains." The abstract is now in proper form and withdrawal of the objection is respectfully requested.

THE CLAIMS ARE NOT OBVIOUS

Claims 1-10, 12-14, and 17-19 stand rejected under 35 U.S.C. § 103(a) as being unpatentable over Reid et al. (U.S. Patent No. 6,086,792). Applicant respectfully traverses the rejection.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success. Finally, the prior art reference (or references when combined) must teach or suggest all the claim limitations. *See* MPEP 2143.

The Examiner offers no motivation to modify the disclosure of Reid et al. to arrive at the present invention. On page 5 of the Office Action, the Examiner states that "it would have been obvious to one having ordinary skill in the art of cables at the time the invention was made to modify the carbon black material of Reid to comprise the semi conducting

material being utilize in a cable core having a carbon black particle size of less than 22 nm since, Reid teaches such a configuration is well known in the art of cables.” This statement is factually incorrect. Reid et al. do not teach that it is well known in the art to modify the carbon black of Reid et al. with those having a particle size of than 22 nm. Reid et al. merely disclose that carbon black having a particle size of 22 nm is commercially available. Just because carbon black having particle size of 22 nm is commercially available does not make its substitution for the carbon black of Reid et al. obvious without the prior art suggesting the desirability of the substitution. *In re Mills*, 16 USPQ2d 1430 (Fed. Cir. 1990); *see also* MPEP 2143.01.

Furthermore, Reid et al. actually teach away from using carbon black having particle size less than about 29 nm. Reid et al. disclose a semi-conducting composition comprising an olefinic polymer and carbon black having a particle size of at least 29 nm. Although Reid et al. disclose that carbon black having particle size of 22 nm is commercially available, the reference clearly teach that such small particle size (high surface area) is undesirable because it does not produce smooth extrusion and has high cost (see column 9, lines 2-5). Thus, Reid et al. suggest using carbon black of at least about 29 nm to achieve a proper balance between smoothness and resistivity (see column 3, lines 65-67). Thus, Reid et al. clearly teaches away from using carbon black having a particle size of less than 29 nm, which is exactly what the present invention claims.

Moreover, modification of the invention of Reid et al. with carbon black of the present invention would render the Reid et al. reference unsatisfactory for its intended purpose. It is well known that there is no suggestion or motivation to make the proposed modification, if proposed modification render the prior art invention unsatisfactory for its intended purpose. *In re Gordon*, 221 USPQ 1125 (Fed. Cir. 1984); *see also* MPEP 2143.01. Clearly, Reid et al. teach the use of carbon black having a particle size of at least 29 nm to

achieve a proper balance between smoothness and resistivity (see column 3, lines 65-67). Using a particle size of 15 to 22 nm as proposed by the present invention would produce a semi-conductive composition that does not meet the smoothness requirement of Reid et al. because the surface area is too high (see column 3, lines 65-67; and column 9, lines 2-5).

Therefore, for the reasons given, the Examiner fails to establish a *prima facie* case of obviousness. Accordingly, the rejection under 35 U.S.C. § 103(a) is improper and should be withdrawn.

Claim 11 stands rejected under 35 U.S.C. § 103(a) as being unpatentable over Reid et al. in view of Hendewerk et al. (U.S. Patent No. 6,270,856). Applicant respectfully traverses the rejection.

The deficiency of Reid et al. is discussed above. The Examiner relies on Hendewerk et al. to show a base polymer of ethylene/I-butene having a density of 0.85-0.95 g/cm³. However, because Reid et al. is deficient in rendering the present invention obvious, this deficiency is not satisfied by Hendewerk et al. Accordingly, Reid et al. in view of Hendewerk et al. do not render claim 11 obvious within the meaning of 35 U.S.C. § 103(a).

ALLOWABLE SUBJECT MATTER

Applicant gratefully acknowledges the Examiner indicating Claims 15 and 16 as being allowable if rewritten in independent form.

CONCLUSION

Applicant has responded to the Office action mailed March 12, 2003. All pending claims are now believed to be allowable and favorable action is respectfully requested. A Petition for a three-month extension of time and fee therefor are filed herewith.

In the event that there are any questions relating to this Amendment or to the application in general, it would be appreciated if the examiner would telephone the undersigned attorney concerning such questions so that the prosecution of this application may be expedited.

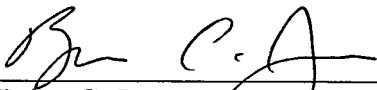
Please charge any shortage or credit any overpayment of fees to BLANK ROME LLP, Deposit Account No. 23-2185 (110938-00132). In the event that a petition for an extension of time is required to be submitted herewith and in the event that a separate petition does not accompany this response, applicant hereby petitions under 37 C.F.R. 1.136(a) for an extension of time for as many months as are required to render this submission timely.

Any fees due are authorized above.

Respectfully submitted,

Date: September 12, 2003

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